

REMARKS

The restriction requirement only groups claims 1-17 and 20, i.e., claims 18 and 19 are ungrouped. However, given the species requirement, Applicants assume that Group I was actually intended to contain claims 1-19. An early notice to that effect is earnestly solicited.

Applicants expressly reserve the right to prosecute any nonelected subject matter in a divisional application should this prove necessary.

With respect to the traversal, Applicants object at the outset to species List II. This List II is compiled from dependent claims 12-14. However, Applicants respectfully point out that, as set forth in MPEP § 1850(II):

“Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims.

* * *

“If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims.”

Therefore, the Examiner should not require a restriction pursuant to List II.

With respect to List I, connexins and innexins are functionally similar alternatives and, therefore, they are properly claimed and examined together. The Examiner says in the middle of page 4 of the restriction requirement that the species do not form a single inventive concept in that they lack the same special technical features. However, the Examiner does not indicate what the Examiner considers to be the special technical feature of either species that is not shared by the other.

MPEP § 1850(III)(B) provides for “[the] situation involving the so-called Markush practice wherein a single claim defines alternatives * * *.” According to this section:

“In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in PCT Rule 13.2 shall be considered to be met when the alternatives are of a similar nature.

“When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

* * *

(B)(2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention belongs.”

As discussed in the instant specification at page 5, lines 18-27; and page 7, lines 12-15, connexins and innexins belong to a recognized class of cell communication proteins, the former being present in vertebrates and the latter in invertebrates.

Applicants respectfully submit that connexins and innexins are sufficiently similar in nature that restriction therebetween is not proper under PCT Rule 13.2.

Therefore, the Examiner should not require restriction pursuant to List I.

Finally, with respect to List III, Applicants point out that claims 17 and 19 depend upon claim 11. Accordingly, in the event that claim 11 is found to be allowable over the prior art, then at least claims 17 and 19 should be rejoined and examined. See MPEP § 1893.03(d) (“Any nonelected processes of making and/or

using an allowable product should be considered for rejoinder following the practice set forth in MPEP § 821.04(b).")

Early and favorable action is earnestly solicited.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By 

Kurt G. Briscoe
Attorney for Applicant(s)
Reg. No. 38,141
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844